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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,913	01/15/2002	Joseph Mulvey	72856	2492
22242	7590	04/08/2005	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			BAUTISTA, XIOMARA L	
			ART UNIT	PAPER NUMBER
			2179	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/047,913		MULVEY ET AL.	
	Examiner		Art Unit	
	X L Bautista		2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because it lacks a summary of the invention. See MPEP § 608.01(d). Correction is required.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention

described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing, See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7, 11-16, 23-25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by *King et al* (US 6,011,554).

Claims 1, 23 and 28:

King discloses receiving first data from a user representing alphanumeric information and predicting at least one additional item of alphanumeric information (abstract; col. 3, lines 17-20) based upon the first data and a personal context model (col. 3, lines 24-30); modifying the personal language model based upon subsequently entered input data representing alphanumeric information from the user (col. 7, lines 1-42).

Claim 2:

King teaches receiving first data includes detecting bio sourced physical indicia from a user (col. 6, lines 35-40).

Claim 3:

King shows detecting bio-sourced physical indicia from a user includes detecting a keypad key assertion (col. 6, lines 15-40).

Claim 4:

King shows detecting bio-sourced physical indicia from a user includes

detecting a plurality of sequential bio-sourced physical indicia from a user (col. 3, lines 37-50).

Claim 5:

King teaches detecting bio-sourced physical indicia from a user includes detecting multi-tap entry-mode entry-mode bio-sourced physical indicia from a user (col. 3, lines 29-36).

Claim 6:

King teaches detecting bio-sourced physical indicia from a user includes detecting disambiguation entry-mode bio-sourced physical indicia from a user (col. 7, lines 1-12).

Claim 7:

King teaches predicting additional item of alphanumeric information based upon the first data (col. 3, lines 17-20) and a personal context model includes basing the prediction upon a personal context model (col. 3, lines 24-30) comprising previously analyzed alphanumeric information for the user (abstract, lines 10-18). It is clear that King's system analyzes information for the user based on user's frequency of use (personal context).

Claim 11:

King teaches presenting predicted alphanumeric information to the user (col.

7, lines 28-42).

Claim 12:

King teaches presenting predicted alphanumeric information to the user comprises presenting only a single word to the user (col. 3, lines 17-20).

Claims 13 and 14:

King teaches predicting a new item of alphanumeric information based upon the first data and the personal context model when a predetermined period of time expires without the user accepting the additional item of alphanumeric information; this includes predicting the new item when a predetermined period of time determined for the user expires without the user accepting the additional item (col. 15, lines 10-22; col. 18, lines 19-51).

Claim 15:

King teaches presenting a synonym that corresponds to one item of predicted alphanumeric information (col. 11, lines 6-9).

Claims 16 and 24:

King teaches providing a first device that receives the first data (col. 6, lines 35-40); providing a second device that includes the personal context model and providing the personal context model from the second device to the first device (col. 3, lines 15-36, computer system comprises a second device to store the user's most

frequently used words).

Claim 25:

King teaches using the personal language model to predict subsequent alphanumeric information when receiving input data representing alphanumeric information from the user includes using the personal language model to predict subsequent alphanumeric information when receiving input data at the second device representing alphanumeric information from the user (col. 3, lines 15-36).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 8-10, 17-22, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over *King* and *Timmins et al* (US 2004/0096043).**

Claims 8 and 17:

King teaches prediction upon a personal context model comprising previously analyzed alphanumeric information for the user includes basing the prediction upon

previously analyzed alphanumeric information from the user as obtained from the user most frequently used information. King does not teach the prediction is based upon previously analyzed alphanumeric information for the user as obtained from e-mail files for the user. However, Timmins discloses a method for providing an information assistance service including assisting the entry of data into message data fields so that the user can send a message to a desired party. Timmins teaches entry of information obtained from email files (abstract; page 1, pg.0002, 0004, 0005). Therefore, it would have been obvious to one ordinarily skilled in the art to include Timmins's teachings of using data obtained from emails and user profiles in King's invention because the user is provided with words or symbols that are most likely to be used, so that manual entry of characters is reduced.

Claim 9:

King teaches predicting one additional item of alphanumeric information based upon the first data and a personal context model. Timmins teaches the personal context model includes basing the prediction upon the personal context model comprising information content of a previously received message to which the user is replying (page 2, pg. 0008).

Claim 10:

King teaches predicting one additional item of alphanumeric information

based upon the first data and a personal context model. Timmins teaches a personal context model includes basing the prediction upon a personal context model comprising a recipient device to which one additional item of alphanumeric information is likely to be sent (page 1, pg. 0007).

Claim 18:

Timmins teaches providing a plurality of email files for a user includes transmitting some information regarding the plurality of email files to a remote location (page 1, pg. 0006).

Claim 19:

Timmins teaches providing a plurality of email files for a user includes providing subject matter content of the plurality of email files (page 2, pg. 0008).

Claim 20:

Timmins teaches the plurality of email files for a user includes providing some content from an address book (page 1, pg. 0007).

Claim 21:

Timmins teaches plurality of email files. King teaches developing a personal language model for the user based upon a statistical analysis of alphanumeric information usage with respect to user context (col. 7, lines 18-42).

Claim 22:

Timmins teaches plurality of email files. King teaches developing a personal language model for the user based upon a statistical analysis of alphanumeric information usage with respect to user context (col. 3, lines 15-36).

Claim 26:

Timmins teaches receiving portions of the personal language model for the user at a second device includes receiving portions of the personal language model for the user at a second device comprising a two way wireless communication device (page 2, pg. 0020).

Claim 27:

Timmins teaches receiving portions of the personal language model for the user at a second device includes receiving portions of the personal language model for the user at a second device comprising at least one of: a personal digital assistant, a pre-recorded audio playback device, a remote control, a teletext interface (page 5, pg. 0039).

Response to Arguments

5. Applicant's arguments filed 12/9/04 have been fully considered but they are not persuasive.

Applicant argues “King’s embodiment s are limited to detecting and/or displaying a possible *translation* of already asserted keys but does not server to *predict* Additional letters as may next be entered by the user.” (page 9, last 4 lines – page 10, lines 1-2).

In response, King teaches that each object is associated with a frequency of use. An object within the vocabulary modules that match the entered keystroke sequence are identified by the disambiguating system...The objects are listed in the selection list according to their frequency of use. It is clear that King’s system analyzes the information for the user based on the user’s frequency of use.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

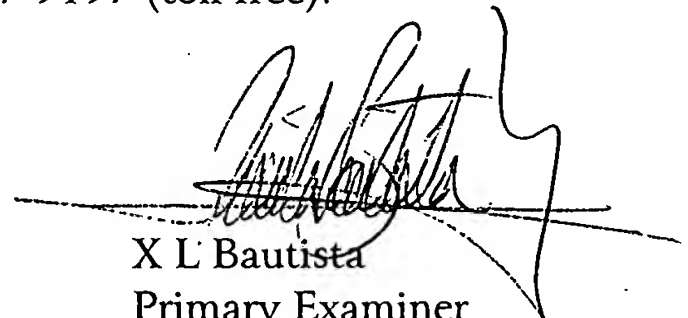
period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X L Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (757) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



X L Bautista
Primary Examiner
Art Unit 2179

xlb
01 April 2005